

**REMARKS**

1. Status of the Claims

Claims 1-22 are pending in this application. Claims 2, 3, 19 and 21 were cancelled. Claim 22 was added. By this Response, Applicants amended claims 1, 4, 12-15, 18 and 20. Applicants respectfully submit no new matter was added and that the amendments are fully supported by the application as originally filed. Accordingly, claims 1, 4-18, 20 and 22 are at issue.

Numerous claims were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appropriate amendments have been made to the subject claims to overcome this rejection. Applicants submit no new matter was introduced with these amendments.

The declaration was objected to for not claiming the application as a national stage application, and for claiming the PCT application as foreign priority. Applicant respectfully disagrees with the objection to the declaration, noting that its application was previously acknowledged as a filing under 35 U.S.C. §371.

2. Rejection of the Claims under 35 U.S.C. §102

Claims 1, 2, 7 and 18-20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,680,556 to Morgan ("Morgan"). In order for a reference to act as a §102 bar to patentability, the reference must teach each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983). Without the required teaching of "each and every element" as set forth in the claims, it is improper to maintain such rejections under §102(b). Applicants respectfully submit that Morgan does not teach each and every element of the claimed invention, specifically as amended, and thus fails as an anticipatory reference.

The present application relates to a diving apparatus, and specifically a dive mask, which includes a support structure for engagement with the diver's head, a lens defining a breathing space

with the support structure, a sealing arrangement such that the breathing space is airtight, and equalization assembly, including an access means so that the diver can use to equalize the pressure in the nasal and ear passages common during diving, and a gas supply.

Morgan describes a diving helmet, having a non-deformable shell which will not collapse upon evacuation of gas from the helmet when the helmet is in the water (col. 2, lines 30-33). The helmet includes an equalizing device 55 for blocking the nose of the diver, having a rod 56 extending through a retainer 52 into the interior of the helmet (col. 4, lines 1-5). Morgan, however, does not teach a nose engaging member that is movable between an inoperative position that is free of the diver's nose, to an operative position to block the diver's nose, nor that the equalization assembly further includes a pocket-shaped flexible membrane having a closed end defining the nose engaging member, the member being dimensioned to accommodate the diver's thumb and forefinger, as in amended claims 1 and 18.

Therefore, because Morgan does not teach each and every element of amended claims 1 and 18, it is submitted that these claims are not anticipated by Morgan. Similarly, because claim 7 ultimately depends from claim 1, and claim 20 depends from claim 18, these dependent claims necessarily include all of the limitations of the respective independent claims, Applicants submit that these dependent claims are likewise not anticipated by Morgan. Applicants also submit that for the above reasons, new claim 22 is also patentable over Morgan.

3. Rejection of Claims under 35 U.S.C. §103(a)

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Winefordner. Claim 3 is cancelled. Applicants respectfully submit that combination of the cited references is improper, but even if proper, Applicants' invention is patentable over the combination of references.

With regard to claim 4, Morgan further lacks an equalization assembly in which two digits of the diver can be received (Office Action, p.6). With regard to claim 5, Morgan lacks the nose engaging member that includes a pair of sockets shaped to receive a digit (Office Action, p.

6). It is further stated that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the equalization assembly of Morgan with the equalization assembly taught by Winefordner so that a user can easily perform an equalization procedure with one hand.” (Office Action, p. 6). Applicants disagree with this conclusion.

Winefordner relates to a dive mask having a flexible skirt having a nose compression recess on each side of a nose enclosure, wherein the recesses permit one-handed finger access to permit the diver to squeeze his or her nostrils together to permit the diver to equalize ear pressure with the water pressure (Abstract). Winefordner does not teach a nose-engaging member that is displaceable between an inoperative and an operative position with respect to the diver’s nose, as described in the present invention. Morgan relates to a dive helmet having an equalization device 55 that is already operable with one hand. Therefore, it does not follow to combine the teaching of Winefordner with Morgan to arrive at the present invention.

Even if Morgan and Winefordner are properly combined, such reasoning for combining these prior art references, however, does not meet the standard set forth by the Supreme Court in *KSR v. Teleflex*. In *KSR*, the Supreme Court stated that a rejection of a patent claim on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007). Contrary to the requirements of *KSR*, the Examiner has merely put forth conclusory statements for the combination. The Examiner has not provided specific reasoning supporting the alleged combinations and thus has failed to present a *prima facie* case of obviousness. Morgan relates to a dive helmet, while Winefordner relates to a dive mask. Structurally, these are completely different devices, and the helmet of Morgan would require complete re-design to try to accommodate the mask of Winefordner. Therefore, it does not follow to combine these references in an attempt to arrive at the present invention.

Moreover, Applicants respectfully submit that the Examiner could only have arrived at a conclusion of obviousness through hindsight analysis by reading Applicants' own inventive teaching and by selecting those elements from Morgan and Winefordner that are deemed relevant to the teachings of the present invention. Such decomposition of an invention "into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q. 2d 1801, 1817 (N.D. Ill. 1993). The Federal Circuit has specifically noted:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . . [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

*In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

Unless the references suggest the particular combination of elements themselves, they cannot show the actual invention was obvious. *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q. 2d 1801, 1817 (N.D. Ill. 1993). In other words, it is impermissible for the Examiner to select certain elements from Winefordner, and ignore the other structural teachings of Morgan, which were described above. Given the distinct structural differences of these references, no one skilled in the art would combine these references. Morgan describes a helmet formed from a non-deformable shell, which will not collapse upon evacuation of the gas from the helmet when the helmet is underwater (col. 2, lines 30-33). On the other hand, Winefordner describes a diving mask having a frame surrounded by a flexible skirt, made of flexible, rubber-like material (col. 2, lines 46-49). The skirt is further shaped to include a nose enclosure, having nose compression recesses on either side of the skirt (col. 2, lines 62-66). Structurally, Morgan is completely different from Winefordner. Morgan describes a solid helmet covering the entire head of the diver with a non-deformable shell, while Winefordner describes use of a flexible skirt which forms the water-tight seal when pressed against the diver's face. Given the ridge structure of Morgan, there is no possible way that the flexible nose compression recesses of Winefordner could be added to the helmet of Morgan without extensive re-design that is simply not feasible with the structure of Morgan. It is clear the Examiner has attempted to take the "choice" features of Morgan and Winefordner in an attempt to combine them to arrive at the present invention. However, given the distinct structural differences of the references, one skilled in the art would not be motivated to combine the teachings of Morgan with Winefordner. Furthermore, Applicants do not see how the combination of Morgan with Winefordner results in performing an equalization procedure.

In view of the forgoing, Applicants submit that it is error to combine the cited references to render the claimed invention obvious. Furthermore, to use the present application as a reason to combine the references is an improper hindsight analysis expressly prohibited by the Federal Circuit. *In re Fine*, 837 F.2d at 1075, 5 U.S.P.Q. at 1600. Finally, Applicants respectfully submit

that because claims 3-5 depend from claim 1 and include all of its limitations, these claims are likewise not obvious in view of the cited references.

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Winefordner and further in view of U.S. Patent No. 4,077,068 to Anderson (“Anderson”). Anderson relates to a conventional diving mask, not a diving helmet. Applicants respectfully submit that the addition of Anderson does not make up for the deficiencies of the combination of Morgan and Winefordner. Furthermore, Applicants respectfully submit that because claim 6 ultimately depends from claim 1 and includes all of its limitations, and claim 1 is patentable over Morgan, claim 6 is likewise patentable over the combination of references.

Claims 8 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan in view of U.S. Patent No. 6,070,577 to Troup and U.S. Patent No. 3,351,089 to Garrahan. Applicants respectfully submit that the addition of Troup and Garrahan do not make up for the deficiencies of the combination of Morgan. Furthermore, Applicants respectfully submit that because claims 8 and 12 ultimately depend from claim 1 and necessarily include all of its limitations, and claim 1 is patentable over Morgan, claims 8 and 12 are likewise patentable over the combination of references.

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Troup and Garrahan and further in view of U.S. Patent No. 5,040,528 to O’Neill. Applicants respectfully submit that because claim 9 ultimately depends from claim 1 and necessarily include all of its limitations, and claim 1 is patentable over Morgan, claim 9 is likewise patentable over the combination of references.

Claims 10 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Troup, Garrahan and O’Neill and further in view of U.S. Patent No. 5,607,258 to Eungard. Applicants respectfully submit that because claims 10 and 11 ultimately depend from claim 1 and necessarily include all of its limitations, and claim 1 is patentable over Morgan, claims 10 and 11 are likewise patentable over the combination of references.

Claims 13-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Troup, Garrahan and further in view of U.S. Patent No. 5,52,091 to Rudolf. Applicants respectfully submit that because claims 13-16 ultimately depend from claim 1 and necessarily include all of its limitations, and claim 1 is patentable over Morgan, claims 13-16 are likewise patentable over the combination of references.

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Troup and Garrahan and further in view of Rudolf. Applicants respectfully submit that because claim 9 ultimately depends from claim 1 and necessarily include all of its limitations, and claim 1 is patentable over Morgan, claim 9 is likewise patentable over the combination of references.

**CONCLUSION**

In light of the foregoing reasons, Applicants respectfully request reconsideration and allowance of claims 1, 4-18, 20 and 22. The Commissioner is authorized to charge any additional fees or credit any overpayments associated with this Amendment to Deposit Account 13-0206.

Applicants further invite the Examiner to contact the undersigned representative at the telephone number below to discuss any remaining matters pertaining to the present application.

Respectfully submitted,

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